

## UNITED SINTE DEPARTMENT OF COMMERCE Patent and Trademark Office

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 APPLICATION NO.
 FILING DATE
 FIRST NAMED INVENTOR
 ATTORNEY DOCKET NO.

 109/670, 118
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 DARSILLO
 M
 99078X206650

IM52/1019

MICHELLE B LANDO CABOT CORPORATION BILLERICA TECHNICAL CENTER 157 CONCORD ROAD BILLERICA MA 01821-7001 EXAMINER

BERNATZ, K

ART UNIT PAPER NUMBER

1773

DATE MAILED:

10/19

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks** 

Office Action Summary    Examiner	~ <u>h</u>		Application No.	Applicant(s)	
Revin M Bernstz   1773   1773   1775   177	, ~		09/670,118	DARSILLO ET AL.	
The MALING DATE of this communication appears on the cover sheet with the correspondence addross Period for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ! MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  Education of the marph or available under the procrision of 3° CFR 1.136(a). In one orent, however, may a reply be timely filed after SIX (6) MONTHS from the maling date of this communication, and year the six (7) (6) MONTHS from the maling date of this communication.  If NO print for engly is specified used the third proclaims of 3° CFR 1.736(b).  If NO print for engly is specified used to the specified day with all operations to become ADMONED (55 U.S.C. § 113).  If NO print for engly is specified used to exclude placed for reply will, by statidar, cause the application to become ADMONED (55 U.S.C. § 113).  Period of the same diplatinent. See 3° CFR 1.704(b).  Status  1) Responsive to communication(s) filed on	**	Office Action Summary	Examiner	Art Unit	
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A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  Letterwise from the complete production of TOPR 1.35(a), in no event, however, may a reply be timely filled between the control of the period for reply is specified above. In breatment settlence produced and the period for reply is specified above. In breatment settlence produced and settlence produced and the period for reply is specified above. In breatment settlence produced and settlence produced by the Olitical bate than their (20) days, a reply within the statistical produced by the Clinical bate than their (20) days, a reply within the statistical produced by the Clinical bate than their (20) days, a reply received by the Olitical bate than their (20) days.  Any reply received by the Olitical bate than their (20) days, a reply within the days and village sets (5) (the MONTS for the mentiling date of this communication, wen if trendy filed, may reduce any commerciated them adjustment. Set 3° CPR 1.704(b).  Status  1) Responsive to communication(s) filed on					
1) Responsive to communication(s) filed on	A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).				
2a)  This action is FINAL. 2b)  This action is non-final.  3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4)  Claim(s) 1-23 is/are pending in the application.  4a) Of the above claim(s)  is/are withdrawn from consideration.  5)  Claim(s)  is/are allowed.  6)  Claim(s)  is/are rejected.  7)  Claim(s)  is/are objected to.  8)  Claim(s)  1-23 are objected to.  8)  Claim(s)  1-23 are objected to by the Examiner.  10)  The drawing(s) filed on  is/are: a)    accepted or b)    objected to by the Examiner.  10)  The proposed drawing correction filed on  is: a)    approved by    disapproved by the Examiner.  11)  The proposed drawing correction filed on  is: a)    approved by    disapproved by the Examiner.  12)  The oath or declaration is objected to by the Examiner.  Priority under 35 U.S.C. §§ 119 and 120  13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a)  All b)  Some * c)  None of:  1   Certified copies of the priority documents have been received in Application No.  papilication from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  a)  The translation of the foreign language provisional application has been received.  15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 120 and/or 121.  Attachment(s)		Responsive to communication(s) filed on			
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## DETAILED ACTION

## Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - Claims 1 7, 27 and 28, drawn to a magnetic recording medium,
     classified in class 428, subclass 694ST.
  - II. Claims 8 24, drawn to a coating composition comprising alumina and a method of preparing a coating composition comprising alumina, classified in class 106, subclass 401.
  - III. Claims 25 and 26, drawn to a method of preparing a magnetic recording medium, classified in class 427, subclass 487+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an abrasive compound and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the

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inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

- 3. Inventions I and III are related as product made and process of making. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product could be made using wet-on-wet coating instead of drying the coating first.
- 4. Inventions II and III are related as product (and process of making the product) and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case magnetic recording media can be made without the coating composition comprising alumina particles and the coating composition could be used as an abrasive.
- 5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
- 6. A telephone call was not made to request an oral election to the above restriction requirement because of the complexity of the requirement.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

## Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

**KMB** 

October 15, 2001

Paul Thibodeau

Supervisory Patent Examiner Technology Center 1700